

REMARKS

Applicants respectfully request reconsideration of the instant application in the view of the foregoing amendments and the following remarks. Claims 1-13, 15-19, 23, 34, 45 and 47 are *pending*. Claims 14, 20-22, 24-33, 35-44, and 46 have previously *been cancelled* without prejudice or disclaimer. Claims 1 and 47 are *independent*. Claim 47 has been *added*, and claims 1 and 34 have been *amended*; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicants submit that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation application(s). Applicants submit that these new claims and/or claim amendments are supported throughout the originally filed specification, claims and/or figures, and that no new matter has been added by way of these amendments.

Claim Rejections – 35 USC § 103

Claims 1-13, 15-19, 23, 34, and 45 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,721,713 B1 to Guheen et al. (hereafter "Guheen"), in view of U.S. Publication No. 2002/0158918 to Feibush et al. (hereafter "Feibush"), and further in view of U.S. Patent No. 5,132,899 to Fox (hereafter "Fox"). It should be noted that Feibush was filed March 27, 2002, after Applicants filing date of August 30, 2001, and that Feibush claims priority to Provisional Application No. 60/333,112 which was filed on March 28, 2001, less than six months earlier than Applicants filing date of August 30, 2001 and it is not conceded that Feibush was filed in the US before the invention by the Applicants. Without so conceding, Applicants respectfully traverse the Examiner's rejection and submit that a *prima facie* case of obviousness has not been established and that the

pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that, by over-generalizing cited references, the rejections in the September 15, 2008 Final Office Action do not establish the necessary elements of a *prima facie* case of obviousness.

Amended independent claim 1 recites, *inter alia*,

1. A processor-implemented method, comprising:

...

displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types;

determining at least one pattern between said first and said second corporate entity information types based on the comparison; and

constructing a financial product based on said selected and displayed information types and said determined at least one pattern.

Applicants submit that the cited references, taken alone or in combination, do not discuss or render obvious at least these claim elements recited in independent claim 1.

The Examiner notes "Guheen does not disclose displaying, simultaneously, a newly chosen information type... regarding first corporate entity and second corporate entity information types" and also notes that Guheen does not disclose "determining at least one pattern between first and second corporate entity information types based on the comparison" (page 4, September 15, 2008 Final Office Action). The Examiner then alleges that Feibush remedies these deficiencies disclosing the indicated claim elements absent in Guheen, citing page 3, paragraphs 30-31 of Feibush. Applicants respectfully traverse the Examiner's allegation.

Applicants respectfully submit neither the cited portions of Feibush nor the remainder thereof disclose the above indicated claim elements. For example, nowhere in the cited reference is simultaneous display disclosed, let alone "displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types" as required by claim 1. Additionally, as a further example, nowhere in the cited reference is "determining at least one pattern between said first and said second corporate entity information types based on the comparison" disclosed. Instead, the portion of Feibush cited by the Examiner states that "a query is performed in the query space to extract a sub-graph" (Feibush page 3, paragraph 30) and also discusses Feibush's figures 4-7. The Examiner alleges that because "users can review the correlation graphs... over a period of time", Feibush "provides for the evaluation of patterns" (page 7, September 15, 2008 Final Office Action). However, the Examiner provides no evidence from Feibush to support such a statement and is simply injecting non-existing elements. As such, Applicants respectfully traverse the

Examiner's allegation. Applicants also note that figures 4-7 of Feibush are not contained in Provisional Application No. 60/333,112, the document to which Feibush claims priority, as discussed above.

Applicants further note that Fox similarly does not remedy Feibush's deficiency, does not disclose either of the indicated claim elements, and is instead directed to "data collection and processing methods and apparatus for generating a report containing a list of stocks and a cash position for purchase for investment and operating accounts" (Fox column 1, lines 6-10). As such, Applicants respectfully submit that the references, alone or in combination, do not discuss or render obvious either "displaying, simultaneously, said newly chosen information type associated with said first corporate entity information type and said second corporate entity information type, each in separate display panels in the graphical user interface to facilitate a comparison regarding said first corporate entity and said second corporate entity information types" or "determining at least one pattern between said first and said second corporate entity information types based on the comparison", both of which are recited by claim 1.

The Examiner further notes "[n]either Guheen nor Feibush disclose creating a financial product based on the selected and displayed information and said determined at least one pattern" (page 4, September 15, 2008 Final Office Action). The Examiner then alleges that "Fox discloses creating a financial product based on the relationship between displayed information types and patterns" and goes on to cite a number of disparate sections of Fox as supporting the allegation. Applicants respectfully traverse the Examiner's allegation.

Neither the cited portions of Fox nor the remainder thereof disclose the recited claim elements. For example, nowhere in the cited reference is constructing a financial product disclosed, let alone "constructing a financial product based on said selected and displayed information types and said determined at least one pattern" as required by claim 1. Instead, the disparate portions of Fox cited by

the Examiner, "column 1, lines 25-33; column 4, lines 10-15 and lines 56-60; column 5, lines 18-29; column 6, line 65 - column 7, line 26" (page 4, September 15, 2008 Final Office Action), are respectively directed to discussing historical aspects of the NYSE; investment manager screening and listing; investment manager governance reporting; and listings of industries in a file. As such, Applicants submit that Fox does not discuss or render obvious "constructing a financial product based on said selected and displayed information types and said determined at least one pattern" as recited in claim 1. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to why the Examiner believes the cited portions of Fox allegedly disclose the recited claim elements.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. Applicants submit that, by over-generalizing the cited references, the pending rejection fails to consider "all words in [the] claim," as required, for example, by MPEP § 2143.03. For at least these reasons, Applicants submit that Guheen, Feibush, and Fox, alone or in combination, do not discuss or render obvious at least the claim elements discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of the Examiner's rejection.

Furthermore, Applicants submit that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection repeatedly refers to, "one of ordinary skill in the art," (e.g., pages 3, 4 and 6, September 15, 2008 Final Office Action) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith. The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of

ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry."

Applicants also submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how the claimed subject matter would have allegedly been obvious to one possessing that level of skill without applying impermissible hindsight.

Furthermore, Applicants submit claims 2-13, 15-19, 23, 34, and 45 which are directly or indirectly dependent from independent claim 1, are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least the reasons discussed above. Accordingly, Applicants request reconsideration and withdrawal of this basis of the Examiner's rejection.

Although of different scope than the preceding claims, Applicants submit that new independent claim 47 is patentable over Guheen, Feibush, and Fox for at least similar reasons as discussed above.

Conclusion

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-13, 15-19, 23, 34, 45 and 47, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited

reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicants assert that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209.333. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209.333.

In the event that a telephone conference would facilitate examination of the application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,
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